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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,344	07/18/2003	Bruce M. Ruana	RUANA-002CIA	4786

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EXAMINER	
HOGE, GARY CHAPMAN	
ART UNIT	**PAPER NUMBER**
3611	

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/622,344	RUANA, BRUCE M.	
	Examiner	Art Unit	
	Gary C. Hoge	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8,10-12,16-20,23,26 and 27* is/are pending in the application.

4a) Of the above claim(s) *9,21,24 and 25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-8,10-12,16-20,23,26 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 9, 21, 24 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 28, 2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3, 4-8 and 10-12, 14, 16-20, 23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Safety-Grip* in view of Mencarelli et al. (5,348,360).

Safety-Grip discloses the invention substantially as claimed, except that the body is secured to the railing by a zipper connecting its ends, rather than by an adhesive. Mencarelli teaches that it was known in the art to attach a padded hand-grip to an elongated object by using an adhesive. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an adhesive to attach the padded hand-grip disclosed by *Safety-Grip* to the railing, as taught by Mencarelli, in order to keep the grip from slipping on the railing.Regarding claims 3, 10, 14 and 22, the device disclosed by *Safety-Grip* is fabric (claims 3 and 14) bonded to neoprene, which is a synthetic rubber (claims 10 and 22).

Regarding claims 4-7 and 16-19, the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation does not distinguish over the prior art.

Regarding claims 8 and 20, it is not known what type of ink is contemplated for the fabrication of the device disclosed by *Safety-Grip*. However, because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that conventional ink would be suitable for the fabrication of an indicia of the type shown by *Safety-Grip*, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the indicia disclosed by *Safety-Grip* from conventional ink as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Regarding claim 15, the stretchable material disclosed by *Safety-Grip* is neoprene. However, because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that polyester would be suitable for the fabrication of a device of the type shown by *Safety-Grip*, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the device disclosed by *Safety-Grip* from polyester as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Response to Arguments

4. Applicant's arguments filed November 18, 2005 have been fully considered but they are not persuasive.

Applicant alleges that the *Safety-Grip* reference is not prior art because the reference has a date of August 3, 2001, but Applicant's priority date is June 7, 2001. However, the August 3, 2001 date is not the publication date of the reference. It is merely the "capture date" on which the image of the web page was captured by archive.org. Applicant's attention is directed to page 2 of the reference, where the phrase "copyright © 2000 PITCO, Inc." is printed. Therefore, the actual publication date is sometime in the year 2000, so it predates Applicant's priority document by at least six months.

Regarding the merits of the rejection, Applicant states, "*Safety-Grip* fails to disclose a body having a releasable adhesive that is adhered to the outer surface of a railing, as recited in Claim 1." That is true, and that is why the rejection is under 35 U.S.C. §103 and not 25 U.S.C. § 102. The teachings of Mencarelli in combination with the disclosure of *Safety-Grip* render the claimed invention obvious, as stated above.

Applicant states that he "cannot find, nor has Examiner cited, any mention in *Safety-Grip* of the grip suffering from or being vulnerable to slipping on the railing." But the test for obviousness is not only what is expressly stated in the references, but also what would be apparent to one having ordinary skill in the art upon reading the references. Indeed, one would not expect to find a discussion of *Safety-Grip*'s limitations in an advertisement for that product, and therefore it is not surprising that an explicit statement of motivation is not found in the *Safety-Grip* advertisement. Prior art references, whether patents or non-patent literature, rarely

discuss their own failings and shortcomings. However, it is the Examiner's position that it would have been obvious to one having ordinary skill in the art that an object that is secured to a handrail by adhesive would likely be less prone to slippage than a similar object that did not have any adhesive.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary C Hoge
Primary Examiner
Art Unit 3611

gch